

### **REMARKS**

Claims 58-59 and 61-69 are currently pending in this application. In the Office Action mailed on March 18, 2009, claims 58-59, 61-69, and 71 were rejected. Claim 58 has been amended. Claim 71 has been cancelled without prejudice. No new matter has been entered. Applicants respectfully request favorable consideration of the present application in light of the amendments to the claims and the following remarks.

#### **I. Claim Rejections – 35 U.S.C. § 103**

##### **A. Koros, et. al. in view of Allen in view of Ouchi**

Claims 58-59, 61-69, and 71 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Koros, et. al. (U.S. 5,795,291) in view of Allen (U.S. 5,733,288) in view of Ouchi (U.S. 5,899,850). Applicants respectfully traverse this rejection as set forth below.

The Office Action states on page 6 that the structure recited in the method is not afforded patentable weight because said structure does not affect the method in a manipulative sense. Claim 58 has been amended such that the structure does affect the method in a manipulative sense. In particular, amended claim 58 explicitly states that the protector is positioned “such that said first blade member prevents neural tissue from migrating into said working channel and said second blade member prevents at least one of dura tissue and vasculature from migrating into said channel. Thus, the protector has a generally V-shaped construct because its purpose is to protect at least two of the nerve root, dura tissue, and vasculature tissue from the brush member of the claimed invention. The protector accomplishes this goal by having one blade member protect against neural tissue entering the working channel and a second blade member protect against dura or vasculature entering the working channel. This is supported in the specification on page 20 (PCT Publication No. WO 04/24005). Thus, the generally V-shaped construct of the protector is *not* a mere design choice, but rather affects the claimed method in a manipulative sense.

In light of the above, none of the Koros, Allen, nor Ouchi references, alone or in combination, appear to teach or disclose each and every element found in claim 58, such that the rejection under 35 U.S.C. § 103(a) should be withdrawn. More particularly, Koros, Allen, and Ouchi fail to teach or disclose the limitation of claim 58 where the blade members are fixed in position relative to one another to form a generally V-shaped construct. Koros discloses a surgical retraction assembly including a plurality of blades extending generally perpendicularly from a rack (Fig. 1). Notably, the blades are moveable relative to one another so as to expand an incision into an operative corridor (col. 3 lines 35-67). The blades are not provided in a fixed orientation relative to one another, and furthermore to do so would be contrary to the teachings of Koros, since one would be unable to satisfactorily expand an incision with blades that were fixed in position relative to one another.

Neither Allen nor Ouchi cure the defect of Koros. The Allen reference does not appear to disclose any kind of protector, much less one in which the blade members are fixed in position relative to one another to form a generally V-shaped construct.

Ouchi fails to cure the aforementioned deficiencies in what was fairly taught by Koros and Allen. Ouchi may disclose a cover tube (Fig. 16, ref. 5) that encloses the brush portion (Fig. 16, ref. 2). However, Ouchi does not disclose a protector having generally rectangular, planar blade members fixed in position relative to one another to form a generally V-shaped construct as claimed by Applicant. Ouchi discloses a cover tube that is made up of arc segments curving towards the brush portion (Fig. 4, ref. 14A). The Ouchi cover tube contains slits (Fig. 4, ref. 6) forming openable portions (Fig. 4, ref. 14A) that are able to move relative to one another. Thus, Ouchi fails to disclose a protector having generally rectangular, planar blade members fixed in position relative to one another to form a generally V-shaped construct as claimed by Applicant.

For at least this reason, one of ordinary skill in the art would not have been motivated to combine the Koros, Allen and Ouchi references, nor would such a combination have led them to arrive at the present invention as claimed. Because Koros, Allen, and Ouchi fail to teach or

disclose every claimed feature in the independent claim 58, Applicants respectfully submit that the rejection under 35 U.S.C. § 103(a) should be withdrawn in favor of an indication of allowance, which is hereby earnestly solicited. Claims 59 and 61-69, being dependent upon and further limiting claim 58, should be allowed for the reasons set forth above in support of the allowability of claim 58, as well as the additional features they contain. Applicants respectfully request that the rejection of claims 58, 59, 61-69 be withdrawn in favor of an indication of allowance, which is hereby earnestly solicited.

**CONCLUSION:**

The foregoing Amendment has been submitted to place the present application in condition for allowance. It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue, or comment does not signify agreement with or concession of that rejection, issue, or comment. In addition, because the agreements made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. Favorable consideration and allowance of the claims in this application is respectfully requested. In the event that there are any questions concerning this Amendment or the application in general, the Examiner is cordially invited to telephone the undersigned attorneys so that prosecution may be expedited.

Respectfully submitted,  
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